REMARKS:

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of the Claims

Claims 1, 3-11, 13-15 and 17-23 are pending in this application. Claims 1 and 11 are independent. The remaining claims depend, directly or indirectly, from claims 1 or 11.

Claim Amendments

Applicant's April 7, 2010 amendments inadvertently excluded the language of some claim amendments presented in Applicant's Preliminary Amendment of December 9, 2004. A number of the omitted December 9, 2004 amendments eliminated the multiple dependency issues to which the Examiner now objects. For simplicity, Applicant herein amends the claims with respect to claims as presented in the April 7, 2010 amendments.

Claims 3-11 were amended to eliminate multiple dependency issues raised by the Examiner and recapture the preliminary amendments overlooked in the April 7, 2010 amendments. In making the above amendments, Applicant's intention is not to narrow the scope of the protection sought by these claims. No new matter has been added by way of these amendments.

Claim Objections

Claims 4-10 are objected to as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claims. Applicant believes the objection is moot in light of the above amendments.

Rejection Under 35 U.S.C. § 103

Claims 1, 3, 11, 13-15 and 17-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,951,771 to Burger in view of U.S. Patent No. 4,116,790 to Prestridge.

Burger discloses a process for treating a hydrophobic viscous feed. The process includes injecting water into the hydrophobic feed, subjecting the mixture to an electrical field that coalesces the water droplets to form a first underflow stream, and centrifuging the first underflow stream to separate the solids into a second underflow.

Prestridge discloses a process for separating an oil/water mixture by exposing the mixture to an electric field to coalesce water drops in the mixture into larger drops and centrifuging the mixture to separate the water and oil into different streams.

Section 2143.03 of the M.P.E.P. requires consideration of every claim feature in an obviousness determination. Rather than merely consider each and every feature of the claim language, the asserted combination of the references much also teach or suggest each and every claim feature. *See In re Royka*, 490 F.2d 981 (CCPA 1974). The Board of Patent Appeal and Interferences has recently confirmed that a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention – including all its

limitations – with the teaching of the prior art." *See In re Wada and Murphy*, Appeal 2007-3733 (BPAI 2008) (*citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). This rational was recently buttressed by the Supreme Court holding that "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (quoting In re Kahn 441 F.3d 977, 988 (Fed. Cir. 2006).

Because, the combination of Burger and Prestridge fail to disclose all elements of Applicant's claims 1 and 11, Examiner did not establish that either claim is *prima facie* obvious. Specifically, both Burger and Prestridge fail to teach or even suggest Applicant's step of "exposing the fluid to an ***electric field having a strength lower than that required to coalesce the water droplets of the emulsion*** to electrically migrate particulate solids suspended therein." *See* Claims 1 and 11 (emphasis added).

In fact, both Burger and Prestridge actually teach away from applying a field strength too low to coalesce water in the emulsion. Burger expressly teaches that his process coalesces the water droplets. Burger states "[t]he electric field causes the droplets of the aqueous phase, as the disperse phase to elongate and to become essentially a charged particle..." *See* Burger at Col. 2, lines 63-65. And Burger states, "[a]ccordingly, the droplets will be attracted toward each other to assist in the ***coalescence***, or the joinder of the smaller droplets to form larger drops." *See* Burger at Col. 3, lines 3-5 (emphasis added).

Similarly, Prestridge also expressly teaches that his process coalesces water with an electric field. Prestridge states "[i]t was the water drops which readily accepted the positive charge and coalesced in the electric field." *See* Prestridge at Col. 5, lines 54-56. Like Burger,

Prestridge contradicts completely Applicant's claims 1 and 11, which expressly claim that the electrical field has "a strength ***lower*** than that required to coalesce the water droplets." *See* Claim 1 (emphasis added).

Burger and Prestridge do not support rejection of claims 1 or 11 because they fail to teach or suggest, and actually teach away from, "exposing the fluid to an electric field having a strength lower than that required to coalesce the water droplets of the emulsion to electrically migrate particulate solids suspended therein." Thus, Examiner has not established that claim 1 is *prima facie* obvious over Burger and Prestridge. For these reasons alone, the rejection under §103 must be withdrawn.

Further, because claims 3-10, 13-15, and 17-23 depend from claim 1 or 11, and are thus narrower in scope, they are also patentable over Burger and Prestridge.

CONCLUSION:

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below.

Please apply any charges not covered, or any credits, to Deposit Account 13-3082 (Reference Number PA-00422US1).

Respectfully submitted,

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